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| 09/784,045                                      | 02/16/2001  | William D. Kirsh     | 462322000100                    | 2531                        |
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| CipherLaw<br>PO Box 34783<br>Bethesda, MD 20827 |             |                      | EXAMINER<br>MORGAN, ROBERT W    |                             |
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* WILLIAM D. KIRSH,  
PETER M. KRAMER, and  
JEFFREY T. KING

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Appeal 2011-000822  
Application 09/784,045  
Technology Center 3600

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*Before* BIBHU R. MOHANTY, MEREDITH C. PETRAVICK, and  
MICHAEL W. KIM, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

William D. Kirsh et al., (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-11, 14-21, and 23. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing was held on February 22, 2012.

Claims 12 and 13 are also pending and rejected in the application. However, the Appellants state that claims 12 and 13 are not being appealed (App. Br. 2) and make no arguments directed to the rejection of these claims. Accordingly, we will treat claims 12 and 13 as having been withdrawn from appeal (*see Ex parte Ghuman*, 88 USPQ2d 1478, 1480 (BPAI 2008) (precedential)). As a consequence, upon return of the application to the Examiner, the Examiner should cancel claims 12 and 13 pursuant to MPEP § 1215.03 (8<sup>th</sup> ed. Rev. 6, Sep. 2007).

Claim 22 has been canceled.

## SUMMARY OF DECISION

We REVERSE.<sup>1</sup>

## THE INVENTION

This invention is “a system and method for standardized and automated appeals or a dispute resolution process over a distributed network for regulated or contractual denials of certain benefits.” Spec. 1:4-6.

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<sup>1</sup> Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Apr. 23, 2010) and Reply Brief (“Reply Br.,” filed Jul. 26, 2010), and the Examiner’s Answer (“Ans.,” mailed May 26, 2010).

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A computerized method for an automated appeal process for a provider, comprising:  
receiving provider identification from a remote provider computer by an electronic network;  
receiving appeal data from the remote computer by the network, wherein the appeal data comprises data descriptive of a plurality of insurance appeals;  
electronically storing the appeal data from the remote computer in a computerized appeals database;  
sending the appeal data to an appeals unit by the network;  
receiving appeal status information for a plurality of appeals from the appeals unit by the network;  
and  
sending appeal status information to a provider at the remote computer by the network, wherein the appeal is a request for reconsideration of a claim adjudicated by an insurer.

#### THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

|           |                 |               |
|-----------|-----------------|---------------|
| Barber    | US 4,858,121    | Aug. 15, 1989 |
| Burchetta | US 6,330,551 B1 | Dec. 11, 2001 |
| Israel    | US 6,766,307 B1 | Jul. 20, 2004 |

Cardiff Software Announces TELEform MediClaim Module, PR Newswire, New York, May 1, 1998, pp. 1-3, [Hereinafter,Cardiff.]

The Examiner took Official Notice that “formatting appeal information according to public laws and regulations are old and well known in the art. For example, each state may have different laws and regulations that govern a settle amount insurance company’s pay for an adjudicated claim.” Ans. 21-22. [Hereinafter, Official Notice I.]

The Examiner took Official Notice that “in the medical industry state laws and regulations provide guidance to physician and patient in determin[ing] reimbursement amounts or appeal information for health care insurance claims.” Ans. 30. [Hereinafter, Official Notice II.]

The following rejections are before us for review<sup>2</sup>:

1. Claims 1, 3, 4, and 6-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Burchetta.
2. Claims 2 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Burchetta and Israel.
3. Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Burchetta and Barber.
4. Claims 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Burchetta and Official Notice I.
5. Claims 14-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Burchetta and Newswire.
6. Claim 23 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Burchetta, Newswire, and Official Notice II.

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<sup>2</sup> The Examiner has withdrawn the rejection of claim 23 under 35 U.S.C. § 112, first paragraph. Ans. 31. The Examiner’s Answer also mentions a rejection of claim 22 under 35 U.S.C. § 112, first paragraph. *Id.* However, claim 22 has been canceled. App. Br. 2.

## ISSUES

The first issue is whether claims 1, 3, 4, and 6-8 are unpatentable over Burchetta. Specifically, the issue is whether the Examiner established a prima facie showing that one of ordinary skill in the art would find the claimed method for an automated appeal process, where an appeal is a request for reconsideration of a claim adjudicated by an insurer, obvious over Burchetta. The rejection of claims 2 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Burchetta and Israel; claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Burchetta and Barber; claims 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Burchetta and Official Notice I; claims 14-21 under 35 U.S.C. § 103(a) as being unpatentable over Burchetta and Newswire; and claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Burchetta, Newswire, and Official Notice II also turn on this issue.

## ANALYSIS

*The rejection of claims 1, 3, 4, and 6-8 under 35 U.S.C. § 103(a) as being unpatentable over Burchetta*

We are persuaded by the Appellants' argument that the Examiner failed to establish a prima facie showing of obviousness in rejecting independent claim 1. *See* App. Br. 5-8 and Reply Br. 2-6. We agree with the Appellants that the Examiner does not provide evidence or logic to support their conclusion that one of ordinary skill in the art would consider Burchetta's automated dollar disputes to be the claimed appeal that is a request for reconsideration of a claim adjudicated by an insurer. *Id.* "[R]ejections on obviousness grounds cannot be sustained by mere

conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Therefore, we find that the Examiner has failed to establish a prima face showing of obviousness in rejecting claim 1.

Independent claims 3, 4, 7, and 8 recite limitations similar to the limitation at issue above. For the same reasons as provided above, we find that the Examiner has not established a prima facie case of obviousness of in rejecting claims 3, 4, 7, and 8 or dependent claim 6. Accordingly, the rejection of claims 1, 3, 4, and 6-8 under 35 U.S.C. § 103(a) as being unpatentable over Burchetta is reversed.

*The rejection of claims 2 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Burchetta and Israel; the rejection of claims 14-21 under 35 U.S.C. § 103(a) as being unpatentable over Burchetta and Newswire; and the rejection of claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Burchetta, Newswire, and Official Notice II*

Independent claims 2, 11, and 14 recite limitations similar to the limitation at issue above and independent claims 15, 21 and 23 similarly recite that the appeal relates to a request for reconsideration of a determination of entitlement to benefits or services. The Appellants traverse the rejection of these claims for the same reasons as discusses above.

*Additionally see* App. Br. 9-10 and Reply Br. 8-9. For the same reasons as provided above, we find that the Examiner has not established a prima facie case of obviousness of in rejecting claims 2, 11, 14, 15, 21, and 23, and claims 16-20, dependent thereon. We note that the Examiner’s citations to

Israel, Newswire, and Official Notice II fail to cure the deficiency of Burchetta at issue above.

*The rejection of claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Burchetta and Barber and the rejection of claims 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Burchetta and Official Notice I*

These rejections are directed to claims dependent on claims 4 and 8, whose rejection we have reversed above. For the same reasons, we will not sustain the rejections of claims 5, 9, and 10 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.")

#### DECISION

The decision of the Examiner to reject claims 1-11, 14-21, and 23 is reversed.

#### REVERSED

JRG